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7590 Eric JOHN GANDRAS 58 MEADOW WOODS ROAD GREAT NECK, NY 11020			EXAMINER GRAY, PHILLIP A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC JOHN GANDRAS

Appellant

Appeal 2009-001431
Application 10/716,853
Technology Center 3700

Decided: May 28, 2009

Before RICHARD E. SCHAFER, SALLY GARDNER LANE and SALLY
C. MEDLEY, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

The appeal, under 35 U.S.C. § 134, is from a Final Rejection of claims 1-31, 33-44, 46-57, and 59-64. Claims 32, 45, and 58 were canceled. (App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b). We reverse and enter a new grounds of rejection.

The real party-in-interest is said to be Appellant Eric John Gandras.
(App. Br. 2).

Appellant claims a catheter.

The Examiner relied on U.S. Patent 6,030,369, which issued February 29, 2000 (“Engelson”).

The Examiner rejected claims 1-4, 10, 12-20, 23, 25-26, 28-30, 33-35, 38-42, 44, 46-48, 51-55, 57, 59-61, and 64 under 35 U.S.C. § 102(b) over Engelson. Appellant did not argue for the separate patentability of any of the claims. We review independent claim 1, as a representative claim. *See* Bd. R. 37(c)(1)(vii).

The Examiner also rejected claims 5-9, 11, 21-22, 24, 27, 31, 36, 37, 43, 49, 50, 56, 62, and 63 under 35 U.S.C. § 103(a) over Engelson. Appellant did not argue for the separate patentability of any of the claims. We review claim 5 as a representative claim. (*Id.*).

II. LEGAL PRINCIPLES

“During examination, ‘claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re American Academy of Sci. Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

“Anticipation requires a showing that each limitation of a claim is found in a single reference, either expressly or inherently.” *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006).

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field

or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 US 398, 417 (2007).

III. ISSUE

Does Engelson teach a catheter with a curve in a second or end tapered section?

IV. FINDINGS OF FACT

1. Appellant’s claim 1 recites¹:

A catheter for use in pelvic angiographic procedures comprising:
a primary curve;
a first tapered section;
a secondary curve; and
a second tapered section; and wherein the second tapered section has at least one curve.

(App. Br. 6, Claims App’x).

2. Figure 2, including Figures 2A, 2B, and 2C, of Appellant’s specification is reproduced below.

¹ Claim 1 has been reformatted to add indentations for each element. *See* 37 C.F.R. § 1.75(i).

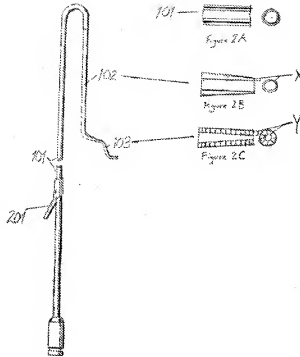
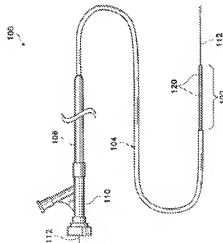


Figure 2 depicts a catheter with at least three curves and two tapered sections, wherein the third curve is tapered, as depicted in Figure 2C.

3. Figure 1 of Engelson is reproduced below.



The inventive catheter (100) shown in FIG.1 has a distal portion (102) having significant flexibility, a middle portion (104) having mechanical properties which vary from more flexible at

the distal end of the portion to stiffer at the proximal end of the portion, and a proximal portion (106).

(Engelson col. 3, ll. 62-65).

4. Figure 2 of Engelson is reproduced below.

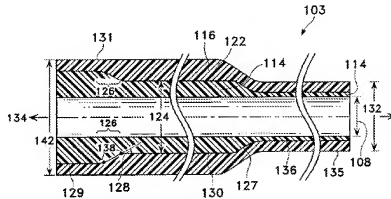


Figure 2 depicts a magnified cross section of a tapered portion of Engelson's catheter. (Engelson col. 4, ll. 14-24).

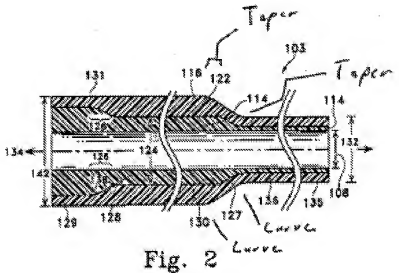
V. ANALYSIS

Appellant's claim 1 recites a catheter with two curved sections and two tapered sections, "wherein the second tapered section has at least one curve." (FF² 1).

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) over Engelson. Engelson teaches a catheter that is depicted as having two curved sections (one between elements 106 and 104, and one between elements 104 and 102) and two tapered areas (one at the end of element 106 and one at the end of element 102). (FF 3).

² Finding of fact.

The following is a reproduction of the Examiner's annotated version of Engelson Figure 2.



(Ans. 10). The Examiner's version of the figure labels the tapers as "curves." However, neither the specification (*see e.g.*, Figure 2; (FF 2)), the language of the claim, nor our understanding of the ordinary meaning of the terms "tapers" and "curves" supports a claim interpretation where these terms have the same meaning. In particular, the specification shows a narrowed section that is said to be "tapered" and within that section a bending that is said to be a "curve." Additionally, the claim refers separately to "tapered sections" and "curves" leading us to conclude that these are different features of the claimed catheter. Finally we understand a taper to be a narrowing while a curve is a bending. Thus, we do not agree that the tapers of the catheter taught by Engelson are "curves" as that word is used in Appellant's claim 1.

Accordingly, we do not agree that Engelson teaches each and every limitation recited in Appellant's claim 1. *See Atofina*, 441 F.3d at 998.

The Examiner rejected claim 5³ under 35 U.S.C. § 103(a) over Engelson. We find that Engelson does not teach a second tapered section having a curve. The Examiner did not explain why it would have been obvious to add a curve to the second tapered section of the catheter taught by Engelson. Thus, we conclude that this rejection is also in error.

VI. NEW GROUNDS OF REJECTION

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 US 398, 417 (2007).

5. Appellant’s specification teaches that “[t]he pelvic visceral arteries are extremely prone to vasospasm and dissection following selective catheterization. Thus a catheter being introduced into them should be soft and atraumatic if one is to minimize the above complications from occurring” (Spec. 2, second paragraph).

6. Appellant’s specification teaches that element 103 is “soft and floppy. . . .” (Spec. 10, second full paragraph).

7. Engelson teaches that “[d]istal portion (102) is flexible and soft to allow deep penetration into the extraordinary convolutions of neurological

³ Claim 5 recites the catheter of claim 1, “wherein the length from the primary curve to the secondary curve is between 14 cm and 17 cm.” (App. Br. 6, Claims App’x). The Examiner concluded that, though Engelson does not teach these specific dimensions, it would have been obvious for a skilled artisan to modify the dimensions that are taught in Engelson to conform to different parts of the body where the catheter is used. (Ans. 4-6).

vasculature without damaging the tissue walls of such lumens.” (Engelson col. 3, ll. 62-65).

Although Engelson does not teach a catheter with a curve in a tapered section, one skilled in the art would have recognized that that the soft flexible material of the tapered section 102 could easily form a curve when it is introduced into the “convolutions of neurological vasculature”. (FF 7). Moreover, one skilled in the art would have had reason to curve the catheter at this flexible portion so that it might better penetrate these “convolutions.” Thus, we conclude that it would have been obvious to one skilled in the art to form a curve in the second tapered section taught by Engelson.

Since Appellant has not asserted any other limitations as distinguishing the claimed subject matter from the catheter taught by Engelson, we enter a new grounds of rejection of claims 1-31, 33-44, 46-57, and 59-64

VII. CONCLUSION

Engelson does not teach a catheter with a curve in a second or end tapered section, but such a configuration would have been obvious.

VIII. ORDER

Upon consideration of the record and for the reasons given, the rejection of claims 1-4, 10, 12-20, 23, 25-26, 28-30, 33-35, 38-42, 44, 46-48, 51-55, 57, 59-61, and 64 under 35 U.S.C. § 102(b) over Engelson is REVERSED; and

the rejection of claims 5-9, 11, 21-22, 24, 27, 31, 36, 37, 43, 49, 50, 56, 62, and 63 under 35 U.S.C. § 103(a) over Engelson is REVERSED.

Additionally, for the reasons set forth herein, we enter a new grounds of rejection under 37 C.F.R. § 41.50(b) for claims 1-31, 33-44, 46-57, and 59-64 under 35 U.S.C. § 103(a) over Engelson as discussed herein.

37 C.F.R. § 41.50(b) provides that, “[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner; or

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record.

REVERSED; NEW GROUNDS ENTERED 37 C.F.R. § 41.50(b)

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MAT

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